

USSN 10/590,136  
Reply to Non-Final Office Action dated 7/20/09

Customer No. 00027683  
Atty. Dkt. No. 36689.259

**2. RESPONSE/REMARKS**

**2.1 STATUS OF THE CLAIMS**

*Claims 1-7, 9-31, 46-48, 51, 54, and 72-75 were pending at the time of the Action.*

*Claims 2-7, 11-13, and 16-26 have been canceled herein without prejudice or disclaimer.*

*Claims 1, 9-10, 14-15, 27-31, 47, 51, 54, and 72-75 have been amended herein.*

*Claims 1, 9-10, 14-15, 27-31, 46-48, 51, 54, and 72-75 are now pending in the application.*

**2.2 SUPPORT FOR THE AMENDMENT**

The pending claims are fully supported by the original specification and claims as filed. It is Applicants' belief that no new matter is included by entry of the present amendment.

**2.3 AN INFORMATION DISCLOSURE STATEMENT AND REFERENCES ARE PROVIDED**

An Information Disclosure Statement, and a request to charge the required fee, is filed concurrently herewith. Applicants respectfully request that the documents cited therein be made of record in the present application and considered in advance of a subsequent action on the merits.

**2.4 THE OBJECTIONS TO CLAIMS 11, 51 AND 54 ARE OVERCOME.**

*Claim 11 was objected to as containing a typographical error.*

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Applicants appreciate the Examiner's helpfulness in noting this inadvertent error, and have amended the claim to overcome the objection. As such, Applicants respectfully request that it now be withdrawn.

***Claims 51 and 54 were objected to under 37 C.F.R. § 1.75(c) as being in improper form.***

Applicants respectfully traverse. However, in an effort to address the Examiner's concerns, and to facilitate timely and expeditious examination, Applicants have amended the claims to more particularly point out and distinctly claim certain aspects of the invention. In particular, Applicants have amended claims 51 and 54 to remove language that is referential to claim 46, and now believe that the objection has been overcome. As such, Applicants respectfully request that it now be withdrawn.

**2.5 THE REJECTION OF CLAIMS UNDER 35 U.S.C. § 112, 2<sup>ND</sup> PARAGRAPH IS OVERCOME.**

***The Action at page 3 rejected claims 1-7, 9-31, 46-48, and 72-75 under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph, allegedly as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.***

Applicants respectfully traverse. However, in an effort to address the Examiner's concerns, and to facilitate timely and expeditious examination, Applicants have amended the claims to more particularly point out and distinctly claim certain aspects of the invention. Applicants have deleted the term "isolated" from each of parts (a), (b), and (c) in claims 1 and 73, and amended claim 72 to depend from claim 1. Applicants respectfully assert that the rejection has now been overcome, and request that it be withdrawn.

***The Action at page 3 rejected claims 5-7, 13-16, 18-21, 23-26, 46-48, and 72-75 under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph, allegedly as reciting nucleotide sequence numbers that are not***

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*correlated to any particular sequence(s) in the sequence listing.*

Applicants respectfully traverse. However, in an effort to address the Examiner's concerns, and to facilitate timely and expeditious examination, Applicants have amended the claims to include reference to SEQ ID NOs:109-111. Applicants respectfully assert that the rejection has now been overcome, and request that it be withdrawn.

**2.6 THE REJECTION OF CLAIMS UNDER 35 U.S.C. § 112, 1<sup>ST</sup> PARAGRAPH IS OVERCOME.**

*The Action at page 4 rejected claims 5-7, 13-16, 18-21, 23-26, 46-48, and 72-75 under 35 U.S.C. § 112, 1<sup>st</sup> paragraph, allegedly as failing to comply with the written description requirement.*

Applicants respectfully traverse. However, as noted above, Applicants have amended the relevant claims to include reference to the sequences set forth in SEQ ID NO:109, SEQ ID NO:110, and SEQ ID NO:111. As a result, Applicants believe that the written description rejection has also been overcome, and respectfully request that it be withdrawn.

**2.7 THE REJECTION OF CLAIMS UNDER 35 U.S.C. § 102(B) IS OVERCOME.**

*The Action on pages 5-7 rejected claims 1-7, 9-20, 22-25, 27-31, 46-48, and 72 under 35 U.S.C. § 102(b), allegedly as being anticipated by WO 98/30707 to Coffin and Latchman (hereinafter "Coffin").*

Applicants respectfully traverse, and remind the Office that a proper rejection on the grounds of anticipation requires the disclosure, in a single reference, of every element of a claimed invention and requires that each and every facet of the claimed invention be identified in the applied reference. *Ex parte Levy*, 17 USPQ2d 1461 (PTO Bd. App. 1990). As stated in the decision of *In re Bond*, 15

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USPQ2d 1566 (Fed. Cir. 1990): "(f) or a prior art reference to anticipate in terms of 35 U. S. C. § 102, every element of the claimed invention must be *identically shown in a single reference*" (Emphasis added).

At page 6 of the Action, Coffin is said to disclose recombinant HSV vectors comprising an isolated polynucleotide that comprises each of the elements recited in applicants' independent claims. Furthermore, page 14, lines 10-26 of Coffin is cited as teaching "(b) a first LAT insulator/boundary region, consists (*sic*) of a contiguous nucleotide sequence from nucleotide 8365 to nucleotide 9273 of HSV1, operably positioned upstream of said isolated LAT enhancer element." (the Action, last sentence, Page 6).

Applicants respectfully traverse, and note for the record that Coffin does not disclose any isolated polynucleotide comprising: an HSV LAT enhancer element; and either first or second LAT insulator/boundary regions that consist essentially of, or alternatively consist of, *a specific contiguous nucleotide sequence from any one of SEQ ID NO:109, SEQ ID NO:110, or SEQ ID NO:111 operably positioned upstream or downstream of the LAT enhancer element*, as now recited.

Similarly, the reference also does not teach or suggest any of the particular isolated polynucleotides of the invention as set forth in independent claims 1 and 73 that comprise "(a) an HSV LAT enhancer element that consists essentially of a contiguous nucleotide sequence from about nucleotide 118,975 to about nucleotide 120,471 of SEQ ID NO:109, SEQ ID NO:110, or SEQ ID NO:111; (b) a first LAT insulator/boundary region that consists essentially of a contiguous nucleotide sequence from about nucleotide 8365 to about nucleotide 9273 of SEQ ID NO:109, SEQ ID NO:110, or SEQ ID NO:111, operably positioned upstream of the LAT enhancer element;

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and (c) a second LAT insulatory/boundary region that consists essentially of a contiguous nucleotide sequence from about nucleotide 120,208 to about nucleotide 120,940 of SEQ ID NO:109, SEQ ID NO:110, or SEQ ID NO:111, operably positioned downstream of the LAT enhancer element.”

Because Coffin fails to disclose each and every element of the claimed invention, it *cannot* anticipate the claimed invention within the meaning of 35 U. S. C. § 102; thus the present rejection is improper. Applicants respectfully request, therefore that the rejection be withdrawn.

## 2.8 PROVISIONAL REQUEST FOR EXAMINER INTERVIEW

Pursuant to M.P.E.P. § 713.01 and 37 C.F.R. § 1.133, Applicants hereby provisionally request an interview between the Office and the undersigned representative should any specific concerns remain following Examiner Hibbert's entry of the amendment and consideration of the remarks and arguments herein.

In order to facilitate an expeditious conclusion of prosecution on the merits in the present application, and to permit expedited allowance and issuance of the pending claims, Applicants provide constructive notice of the undersigned's availability and willingness to conduct such an interview with the Office, preferably within the next 30 days, if any issues remain outstanding. Applicants appreciate in advance the Examiner's willingness to participate in such an interview if it be deemed constructive to advancing the present application to allowance.

## 2.9 CONCLUSION

It is respectfully submitted that all claims are fully-enabled by the Specification, that all

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pending claims are definite, and that the inventions embodied in those claims are useful, novel, and non-obvious. Applicants believe that the claims are acceptable under all sections of the Statutes and are now in condition for ready allowance. Applicants earnestly solicit concurrence by the Examiner and the issuance of a Notice of Allowance in the case with all due speed. Applicants note for the record their explicit right to re-file claims to one or more aspects of the invention as originally claimed in one or more continuing application(s) retaining the priority claim from the present and parent cases.

Should Examiner Hibbert have any questions, a telephone call to the undersigned Applicants' representative would be appreciated.

Respectfully submitted,



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**Dated: November 20, 2009**  
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**Certificate of Service**

I hereby certify that this correspondence is being filed electronically with the U.S. Patent and Trademark Office via EFS-Web on November 20, 2009.



Michelle Baxter